

REMARKS / ARGUMENTS

Upon entry of the present amendments, claims 12-16 are pending in the application. Claims 1-11 have been canceled, without prejudice. Claim 12 has been rewritten in independent form. Claims 12 and 13 have been amended to substitute the term "an amorphous form" for the term "the liquid form". Claim 16 has been amended to conform the language of the claim to the other dependent claims presented. Support for these claim amendments appears at least in claims 1-16 as originally filed, as well as in the specification as originally filed at least at page 1, ¶ 9 and page 18-19, ¶ 46. The Applicants have amended the specification to provide serial numbers of related applications that were referenced in the specification as filed but were not available to the Applicants at that time. That is, the specification has been corrected by inserting the serial number of the co-pending applications referred to in ¶¶ 3, 4, 5, 58 and 59. The foregoing amendments were made without any intention to abandon any subject matter, but with the intention that one or more claims of the same, lesser, or greater scope may be pursued in a later application or in a continuation, continuation-in-part, or divisional application. The present amendment does not add new matter.

Elections/Restrictions - 35 U.S.C. §121

The Applicants affirm the provisional election of Group III, claims 12-16, drawn to a method of imaging, classified in class 430, subclass 330. Claims 1-11 have been withdrawn from further consideration by the Examiner and have been canceled, without prejudice.

Claim Rejections 35 U.S.C § 103—Obviousness

The Examiner has rejected claims 12-16 under 35 U.S.C. § 103(a) as allegedly unpatentable over JP 62-288828 ("Harada *et al.*"), in light of its English language abstract, in view of Savvin *et al.* (Zh. Anal. Khim., 33, 1473-80 (1978)). In support of the rejection the Examiner has asserted that Harada *et al.*, based upon a spot translation by a PTO staff member, the Examiner alleges that Harada *et al.* discloses a silver halide polymerizable photographic material comprising cyan, magenta, and yellow coloring layers, wherein the layers comprise a leuco dye similar to the instant claim limitations for both the properties and structure as one of the possible dyes suitable for use in the invention, however the invention is not limited thereto. The examiner has also asserted that Savvin *et al.* disclose a known xanthene (leuco) dye having a structure meeting the instant claim limitations. This dye allegedly has a hydrogen bond accepting group and the donating group is stated to be a heterocyclic compound as disclosed within Claim 2.

The Applicants traverse the rejections under 35 U.S.C. § 103(a), as the material of Harada *et al.* could not be used in the method of Claim 12 (as currently amended); and Savvin *et al.* do not disclose a xanthene dye in combination with a hydrogen-bond accepting group having a structure meeting the instant claim limitations.

Claim 12, as currently amended, is directed to an imaging method comprising a) providing an imaging member comprising an image-forming layer including a compound represented by formula (I), said compound being in the crystalline form, and b) converting at least a portion of said compound to an amorphous form in an imagewise pattern whereby an image is formed (emphasis added). Nowhere in Harada *et al.*, nor in Savvin *et al.*, is there a suggestion that a complex formed between a leuco dye and a heterocyclic compound (or indeed any hydrogen-bond accepting compound whatsoever), in a crystalline form, be incorporated into an imaging member. Moreover, in United States Patent No. 4,803,148 (that derives from the disclosure of Harada *et al.* in JP JP 62-288828), in Column 26, line 35, it is stated that the leuco dye is dissolved in trimethylolpropane triacrylate in order to prepare the light-sensitive composition. The dissolution of the leuco dye specifically excludes the possibility that it could be used in the crystalline form. Thus, the imaging member of Harada *et al.* could not be used in the imaging method of Claim 12 of the instant application.

Savvin *et al.* disclose xanthene dyes in combination with a variety of ammonium cations. In particular, the 2:1 1-hexadecylpyridinium salt with 2',3',6',7'-tetrahydroxyspiro[3H-2,1-benzoxathiole-3,9'-[9H]xanthene]-6-sulfonic acid 1,1-dioxide (cited on page 87 of the Examiner's search report) and a similar material exemplified on page 1479 of the cited reference are xanthene dyes with ammonium cations. However, these compounds do not meet the instant claim limitations for the following two reasons:

1. Formula (I) in Claim 12 (as currently amended) specifies a non-ionized hydroxyl group (*i.e.*, an oxygen atom attached to a hydrogen atom) on the benzene ring bearing substituents R₁, R₂ and R₃, positioned between R₁ and R₂ (at the 3'-position of the xanthene). This hydroxyl group is hydrogen-bonded to a hydrogen-bond accepting group denoted by "A" in formula (I). Savvin *et al.* do not show a hydrogen bond. Rather, the hydroxyl group at the 3'-position of the xanthene is ionized. The oxygen atom at the 3'-position does not bear a hydrogen atom, and is negatively charged (as is explicitly shown in the xanthene structure on page 1479 of the reference).
2. Savvin *et al.* do not show a hydrogen-bond accepting group corresponding to "A" in structure (I) of Claim 12 as currently amended, as Savvin *et al.* provides a cation, that may be heterocyclic, in association with the ionized hydroxyl group at the 3'-position of the xanthene.

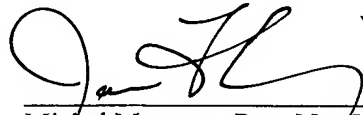
This cation may be a 1-hexadecylpyridinium or other ammonium moiety. The Applicants submit that one of skill in the art would recognize that the 1-hexadecylpyridinium cation, or any ammonium cation whatsoever, cannot be a hydrogen-bond accepting group as provided. Such a group must have relatively high electron density (as would be the case, for example, for a neutral pyridine as opposed to a cationic pyridinium group). One of ordinary skill in the art would recognize that quaternization of a pyridine (in this case by the hexadecyl group) removes the possibility that it could be a hydrogen-bond accepting group. Moreover, between the negatively charged oxygen atom at the 3'-position of the xanthene and the quaternary 1-hexadecylpyridinium cation there is no hydrogen atom that could participate in a hydrogen bond. Instead, there is a salt formed between the xanthene dye and the heterocyclic cation. Moreover, with reference to Savvin *et al.*, the Examiner has stated that "the dye has a hydrogen bond accepting group and the donating group is a heterocyclic compound as disclosed within Claim 2". Office Action at page 4, ¶ 3. This appears to reflect a misunderstanding of formula (I) in Claim 12 as currently amended (and in original Claim 1), in which the dye actually bears the hydrogen bond *donating* group (the hydroxyl group at the 3'-position of the xanthene) and it is the hydrogen bond accepting group ("A" in formula (I)) that is further specified in original Claim 2 to be a heterocyclic compound. In fact, as discussed above, the dye disclosed in Savvin *et al.* bears neither a hydrogen bond donating group nor a hydrogen bond accepting group at the 3'-position of the xanthene, and the heterocyclic compound is neither a hydrogen bond donor nor a hydrogen bond acceptor.

CONCLUSION

On the basis of the foregoing amendments, Applicants respectfully submits that the pending claims are in condition for allowance and respectfully request the same. If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,

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Michel Morency, Reg. No. 50,183
James F. Ewing, Reg. No. 52,875
Attorneys for Applicants
Foley & Lardner LLP.
111 Huntington Avenue, 26th Fl.
Boston, MA 02199
Tel. 617-342-4000
Fax. 617-342-4001